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Box Comments
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Attention Robert W. Bahr

Comments on Proposed Rule Changes to Implement Eighteen-Month Publication of Patent Applications

The following Comments are my own and should not be attributed to any company or organization with which I might be associated.

General questions and comments:

1. Will the United States of America withdraw its reservation made as to Article 64(3) of the Patent Cooperation Treaty (PCT), which provides for no publication of an international application at 18 months if only the United States of America is designated?
2. In view of revised 35 USC 102(e), it would appear that a revised declaration is required under Article 64(4)(c).
3. Can a priority claim be withdrawn by the applicant to recalculate the eighteenth month and thereby delay publication? Withdrawal of priority claims is available under PCT Rule 90*bis*.3.

Comments as to specific proposed rules:

- ◆ Section 1.9: Is it intended to exclude published English language international applications designating the United States of America?
- ◆ Section 1.14: Should 1.14(b)(2) be limited to those international applications which designate the United States of America?
- ◆ Section 1.14(1)(iii): PCT Article 38 would appear to prevent the International Preliminary Examining Authority (IPEA) opening its examination file to the general public as proposed. Unless authorized by the applicant, it is only the Elected Offices, which may obtain copies of the file, held by the International Preliminary Examining Authority, PCT Rule 94.2. PCT Rule 94.3 provides when an Elected Office may make the file available to the public. Accordingly, all reference in the rule to the "Examination Copy" should be deleted. I also doubt that the USPTO has the authority to open the search file used by the USPTO as an International Searching Authority (ISA) to the public. The ISA and IPEA perform their work under an agreement with WIPO and the files are not US national files. Note that the USPTO acts as an ISA and IPEA for foreign countries. It would not appear to be proper to open the foreign applicant's files if the US had not been designated. Note that the work of the USPTO as a Receiving Office is also work performed for applicants under an international treaty and that the Home Copy is not a file of the USPTO. I would suggest that the wording of Section 1.14(1)(i), (ii) and (iii) be deleted until clear authority for such access has been established.

- ◆ Section 1.14(2): How will the public know that an English translation has been filed with the USPTO?
- ◆ Section 1.14(3): Is it required that the applicant has entered the national phase under 35 USC 371 in order for this section to be effective? What file will be made available if no US file wrapper has been prepared?
- ◆ Section 1.14(5): This section appears to be in conflict with Section 1.14(1)(iii).
- ◆ Section 1.55(a)(1)(i): The meaning of "original" application is not clear since it is based on a priority application as referred to in this section.
- ◆ Section 1.55(c): Should "(or intellectual property authority)" be added after "country" in order to conform to the wording of Section 1.55(a)(1)(i)?
- ◆ Section 1.72(a): The limitation to 500 words may be in conflict with PCT Rule 4.3 which specifies that the "title of the invention shall be short (preferably from two to seven words when in English or translated into English..." PCT Article 27(1) provided that no national law shall require compliance relating to form or contents of an international application different from or additional to those which are provided for in the PCT and its Regulations. Although relates to international applications entering the national phase under 35 USC 371, the proposed wording of the rule would relate to such applications.
- ◆ Section 1.78(a)(2): It is not clear how the wording "This reference must be submitted during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the actual filing date of the prior application. The PCT international application filing date is the "actual filing date" (35 USC 363). Since PCT applicants do not need to enter the national phase until 20 or 30 months after the priority date, how is this wording to be interpreted? Possibly wording similar to that in Section 1.97(b)(2) would be better for international applications; "Within four months of the date of entry of the national stage as set forth in § 1.491 in an international application."
- ◆ Section 1.784(a)(2): It is not clear why the expression "Color drawings are not permitted in international applications (see PCT Rule 11.13)" appears in the proposed rule. The PCT Rule is sufficient authority. If in the future there should be a change in the PCT Rule wording, inconsistency would result.
- ◆ Section 1.84(j): Will there be an Official Gazette publication with a figure at the time an application issues as a patent?
- ◆ Section 1.99(e): How will the time limit of "within two months of the date of the publication of the application or prior to the mailing of a notice of allowance, whichever is earlier" apply to international applications entering the US national phase at 20 or 30 months after the priority date? See the comments above to Section 1.78(a)(2).
- ◆ Section 1.137(g): The end of this rule "a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances." does not appear to provide for the

revised wording of Section 119(e) of title 35, United States Code, which was amended by adding at the end the following:

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

- ◆ Section 1.211(a): This Rule seems to say that the USPTO will republish international applications published in English by the International Bureau of WIPO after the applicant has entered the national phase under 35 USC 371. Note the comment in the last full paragraph in the center column of page 17948 of the Federal Register of April 5, 2000. Also note the provisions of PCT Article 29 and that 35 USC 374, Publication of international application specifies that

'The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall confer the same rights and shall have the same effect under this title as an application for patent published under section 122(b), except as provided in sections 102(e) and 154(d) of this title.'

- ◆ It may be desirable to have a rule relating to what fact situation must exist for an international application to have provisional protection rights in the United States. Note the provisions of PCT Article 29(2).

If a further explanation is desired of any of my comments, I may be reached at 301-464-4306 or by e-mail at LMAASSEL@AOL.COM.

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